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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/830,523	07/20/2001	Raymond A. Berard	IRC27514060/	9700

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EXAMINER	
LORENGO, JERRY A	

ART UNIT	PAPER NUMBER
1734	

DATE MAILED: 03/26/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/830,523	BERARD, RAYMOND A.	
	Examiner	Art Unit	
	Jerry A. Lorengo	1734	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *24 November 2003 and 05 January 2004*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-15* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☒ Claim(s) *6 and 8-15* is/are allowed.

6)☒ Claim(s) *1-5 and 7* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date *12/01/2003*.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

(1)

Claim Rejections - 35 USC § 103

The rejection of claims 1, 2, 3, 4 and 7 under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 5,840,773 to Booij et al. in view of U.S. Patent No. 5,605,935 to Parrinello et al. and GB 1,552,626 to Bobe, as generally set forth in the rejection mailed May 20, 2003, stands.

(2)

The rejection of claim 5 under 35 U.S.C. 103(a) as being unpatentable over the references as combined in section (1), above, in further view of U.S. Patent No. 5,096,764 to Terry et al., as generally set forth in the rejection mailed May 20, 2003, stands.

(3)

Allowable Subject Matter

Claims 6 and 8-15 have been found to be allowable over the prior art of record.

(4)

The following is an examiner's statement of reasons for allowance:

Methods for the separation of structural components from floor coverings through contact of a comminuted or cut floor covering material with an extraction agent under heat, such as that disclosed by U.S. patent No. 5,840,773 to Blooij et al., are known in the art. It is also known, such as disclosed by U.S. Patent No. 5,605,935 to Parrinello et al., to separate polyurethane components from a floor covering through heated contact with an organic polyol whereby the reverted polyurethane, now in the form of a polyol, may be collected and reused to form reconstituted polyurethane by the addition of a polyisocyanate thereto. Although floor coverings which utilize polyurethanes as a precoat and/or backing, such as taught by U.S. Patent No. 4,657,790 to Wing et al. and GB 1,552,626 to Bobe, are known, none of the prior art of record specifically teaches or suggests such a method, as set forth in applicant claims 6 and 8 and illustrated in applicant's Figure 2, wherein a floor covering, comprising a facecloth layer and a polyurethane backing layer, is contacted under heated conditions with an organic polyol such that the polyurethane is at least partially liquefied, whereby the backing layer can be separated from a facecloth layer and then contacted with polyisocyanate to reconstitute the separated

backing layer. Although the prior art of record discloses that a backing layer may be separated from a facecloth after a polyurethane precoat disposed therebetween has been converted to a polyol by contact with an organic polyol under heated conditions, none of the prior art of record specifically teaches or suggests the process contemplated by applicant claims 8-15 which require the organic polyol to be applied onto the facecloth layer followed by the pulling of the facecloth away from the backing layer.

Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably accompany the issue fee. Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance."

(5)

Response to Amendments and Arguments

The amendments and arguments filed November 24, 2003 and January 5, 2004 are acknowledged. In response to the amendments to applicant claims 6 and 8 by recasting them in independent form thereby incorporating the subject matter indicated as allowable in the office action mailed May 20, 2003, claims 6 and 8-15 have been passed to issue as set forth and explained in sections (3) and (4), above. The applicant's arguments with regards to the rejection of claims 1-5 and 7 have been considered but are not persuasive.

With regards to the rejection of applicant claims 1-4 and 7, the applicant argues that the combination of the Booij et al., Parrinello et al. and Bobe reference was made with impermissible hindsight. Furthermore, the applicant argues that the Parinello et al. reference is drawn only generally to the recycling of polyurethane foams and not polyurethane from laminated materials.

In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971). In the instant case, only knowledge, which was within the level of

ordinary skill at the time the claimed invention was made, was utilized in forming the grounds of rejection. That is, it is generally known to recycle polyurethane from various materials such as shown by the disclosure of Parinello et al. Furthermore, U.S. Patent No. 5,534,556 to Bauer illustrates prior art evidence of this fact within the realm of laminated polyurethane materials.[1] Therefore, the examiner respectfully submits that no impermissible hindsight was used and further submits that the recycling of polyurethane from polyurethane laminates is known in the art. The rejection of claims 1-4 and 7 thus stands and is made final.

Finally, the applicant again argues that impermissible hindsight was utilized in the selection and combination of the Terry et al. reference, who teach urethane-modified bitumen, in the rejection of claim 5. Again, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. In the instant case, reconstruction is proper as Terry et al. was utilized only as a modification of the proper rejection based on the combination of Booij et al., Parrinello et al. and Bobe to show that urethane-modified bitumen are known and are useful in the formation of floor coverings, such as carpet tiles, which are used in high moisture and high temperature conditions (column 7, lines 19-28). As such, the examiner respectfully submits that the combination was made with proper motivation in the absence of impermissible hindsight. The rejection of claim 5, as reiterated in section (2), above, is therefore proper and made final.

(6)

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after

[1] *See, e.g.*, abstract; column 2, lines 29-35; column 2, lines 13-16; and column 3, lines 56-59.

the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

(7)

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jerry A. Lorengo whose telephone number is (571) 272-1233. The examiner can normally be reached on Monday through Friday, 8:30 A.M. to 5:00 P.M..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Richard Crispino can be reached on (571) 272-1226. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

J.A. Lorengo, Primary Examiner
AU 1734
March 22, 2004